Supreme Court, U.S.
FILED
JUN 3 2001
OFFICE OF THE CLERK

No. 01-1787

In The
Supreme Court of the United States

SIMPLE TECHNOLOGY, INC.
(now known as SimpleTech),

Petitioner,

v.

DENSE-PAC MICROSYSTEMS, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITION FOR WRIT OF CERTIORARI

JOSEPH R. RE
Counsel of Record
JOSEPH F. JENNINGS
JOSEPH S. CIANFRANI
KNOBBE, MARTENS, OLSON & BEAR, LLP
620 Newport Center Drive, 16th Floor
Newport Beach, California 92660
(949) 760-0404
Attorneys for Petitioner Simple Technology, Inc.

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QUESTION PRESENTED

This petition involves the same issue recently decided by this Court in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, No. 00-1543 (U.S. May 28, 2002), *vacating and remanding* 234 F.3d 558 (Fed. Cir. 2000) (*en banc*) (hereinafter "*Festo*"), namely whether the amendment of a patent claim during prosecution completely bars the patentee from relying on the doctrine of equivalents as to the amended claim element. Because the sole basis for the judgment below rested upon the complete bar announced in the Federal Circuit's now-vacated opinion in *Festo*, the question presented is whether the judgment below should be vacated and remanded for further proceedings in light of this Court's decision in *Festo*.

CORPORATE DISCLOSURE STATEMENT

Plaintiff Simple Technology, Inc. (now known as SimpleTech, Inc.) ("SimpleTech") has no parent company. No publicly held company owns 10% or more of SimpleTech's stock.

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Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., No. 00-1543 (U.S. May 28, 2002) ..... *passim*

OTHER AUTHORITIES:

28 U.S.C. § 1254 2

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Supreme Court Rule 10(c) 5

PETITION FOR WRIT OF CERTIORARI

Plaintiff SimpleTech respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case. SimpleTech submits that the Federal Circuit's decision should be vacated and remanded in light of this Court's recent decision in *Festo*.

OPINIONS AND ORDERS BELOW

The district court issued four orders relevant to this petition, each of which is unpublished. *See* App. 3-5 (order granting summary judgment of no literal infringement and denying summary judgment of no infringement under the doctrine of equivalents); App. 6-9 (order granting summary judgment under the doctrine of equivalents); App. 10-28 (statement of uncontroverted facts and conclusions of law with respect to the doctrine of equivalents); App. 29-30 (final judgment).

The Court of Appeals for the Federal Circuit affirmed the judgment of the district court in an unpublished order without opinion. *See* App. 1-2.

JURISDICTION

The Federal Circuit's Order affirming the judgment of the district court was entered on March 7, 2002. The Federal Circuit's jurisdiction was based on 28 U.S.C. § 1295(a)(1). The district court's jurisdiction was

based on 28 U.S.C. § 1338(a). This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The United States Constitution provides that "Congress shall have the power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. art. I, § 8, cl. 8.

The Patent Act states that "Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent." 35 U.S.C. § 271(a).

STATEMENT OF THE CASE

The judgment of the district court and of the Federal Circuit in this case are squarely based on the vacated opinion of the Federal Circuit in *Festo*, in which the Federal Circuit held that a narrowing amendment creates a "complete bar" on the application of the doctrine of equivalents for the amended claim element. This Court recently vacated the Federal Circuit's decision in *Festo*, overruling the complete bar rule. Because the judgment below with respect to the doctrine of equivalents was premised solely on the Federal Circuit's vacated *Festo* decision, the present case should also be vacated and remanded.

Petitioner SimpleTech sued respondent Dense-Pac Microsystems, Inc. ("Dense-Pac") for infringement of Claim 12 of U.S. Patent No. Re. 36,916 ("the '916 patent"). The patented technology relates to memory modules used in devices such as computers. Claim 12 of the '916 patent, the only claim at issue, claims an apparatus that vertically stacks two or more memory chips while minimizing the overall profile of the memory module. This multi-chip module includes printed circuit boards, referred to in the patent and Claim 12 as "side boards." These side boards are placed on either side of a vertical stack of two or more memory chips. The side boards serve to conductively connect the memory chips to each other and the underlying circuit board.

During patent prosecution before the Patent and Trademark Office ("PTO"), the PTO Examiner rejected Claim 12, among others, in view of U.S. Patent No. 5,343,075 ("the Nishino patent"), which discloses a pair of L-shaped structures on the sides of stacked devices. App. 14-15. To distinguish the L-shaped structure of the Nishino patent, SimpleTech added the word "planar" before the term "side board." App. 16-19. The Examiner agreed that this amendment would render the claims patentable over the Nishino patent, and ultimately issued U.S. Patent No. 5,514,907, which was subsequently reissued as the '916 patent. App. 19-21.

Dense-Pac makes and sells stacked memory products wherein memory chips are stacked between printed circuit boards. In the accused Dense-Pac products, the printed circuit boards on either side of the stacked memory chips are made of two pieces, whereas the printed circuit boards shown in the '916 patent are made of a single piece. The district court initially granted summary judgment that

Dense-Pac's printed circuit boards were not literally "planar side boards" as recited in Claim 12 of the '916 patent, but denied Dense-Pac's motion for summary judgment that prosecution history estoppel precluded infringement under the doctrine of equivalents. App. 4-6, 12-13.

At the final pretrial conference, Dense-Pac requested leave to file another motion for summary judgment in view of the Federal Circuit's then-recent *Festo* decision. The district court granted Dense-Pac leave, and thereafter granted the new summary judgment motion on the grounds that all equivalents for the "planar side board" claim limitation were completely barred under the Federal Circuit's *Festo* decision. App. 6-9, 24-27. The district court explained its reasoning for granting summary judgment despite its previous ruling that SimpleTech was entitled to a trial on the merits:

> [T]he Court grants defendant's motion for partial summary judgment on the ground that, under *Festo*, plaintiff is completely barred from seeking infringement on the basis of the doctrine of equivalents on account of plaintiff's amendment narrowing the limitation "planar side board."

App. 9. The district court thereafter entered final judgment of no infringement. App. 29-30.

SimpleTech appealed the district court's judgment with respect to both literal infringement and infringement under the doctrine of equivalents to the Court of Appeals for the Federal Circuit. With respect to the doctrine of equivalents, SimpleTech specifically argued that, because the district court's decision on this issue rested solely on the Federal Circuit's *Festo* decision, the case should be remanded to the district court if this Court were to alter

the reasoning of the Federal Circuit's *Festo* decision. On March 7, 2002, the Federal Circuit affirmed the district court's judgment in the instant case without opinion. App. 1-2. On May 28, 2002, this Court altered the Federal Circuit's reasoning in *Festo* by eliminating the complete bar.

REASONS FOR GRANTING THE WRIT

SimpleTech seeks review because this Court's recent opinion in *Festo* eliminated the Federal Circuit's complete bar of the doctrine of equivalents for amended claim elements. *See Festo*, slip op. at 12 ("we disagree with the decision to adopt the complete bar"). This complete bar was the sole basis for the judgment of the district court and the Federal Circuit in the instant case. Accordingly, under Supreme Court Rule 10(c), the decision of the Federal Circuit in this case conflicts with this Court's decision in *Festo*. SimpleTech submits that on remand the evidence will show that SimpleTech's addition of the word "planar" to the asserted Claim 12 of the '916 patent should not bar a finding of equivalence under the guidance this Court outlined in its decision in *Festo*.

As this Court explained in *Festo*, "[t]he Court of Appeals ignored the guidance of *Warner-Jenkinson*, which instructed that courts must be cautious before adopting changes that disrupt settled expectations of the inventing community." *Festo*, slip op. at 14. This case exemplifies the disruption of settled expectations caused by the now-overruled complete bar announced in the Federal Circuit's *Festo* decision. Before the Federal Circuit's *Festo* decision, the district court was prepared to conduct a jury trial on SimpleTech's patent infringement claim based on the

doctrine of equivalents. *See* App. 4, 6, 12-13. Only after the Federal Circuit issued its *Festo* decision did the district court (and the Federal Circuit) determine that SimpleTech's claim should be dismissed as a matter of law. App. 8-9, 24-27. In view of this Court's vacatur of the Federal Circuit's intervening *Festo* decision, SimpleTech should be given the opportunity to establish that it is entitled to its long-awaited trial on its infringement claim under the doctrine of equivalents. Thus, the instant case should be remanded for evaluation in the first instance of the impact of this Court's decision in *Festo* on the availability of equivalents for the "planar side board" claim limitation of SimpleTech's '916 patent.

CONCLUSION

SimpleTech respectfully requests that the Court grant this petition for writ of certiorari, vacate the decision of the Federal Circuit, and remand this case to the Federal Circuit for proceedings consistent with this Court's recent opinion in *Festo*.

Respectfully submitted,

JOSEPH R. RE
Counsel of Record
KNOBBE, MARTENS, OLSON
& BEAR, LLP
620 Newport Center Drive
Suite 1600
Newport Beach, California 92660
Telephone: (949) 760-0404

Attorney for Petitioner
Simple Technology, Inc.

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. This disposition will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

01-1310

SIMPLE TECHNOLOGY, INC.
(now known as SimpleTech, Inc.),

Plaintiff-Appellant,

v.

DENSE-PAC MICROSYSTEMS, INC.,

Defendant-Appellee.

JUDGMENT

(Filed March 7, 2002)

ON APPEAL from the UNITED STATES DISTRICT COURT CENTRAL DISTRICT OF CALIFORNIA

In CASE NO(S). 98-CV-822

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (LOURIE, *Circuit Judge*, FRIEDMAN, *Senior Circuit Judge*, CLEVENGER, *Circuit Judge*):

AFFIRMED. *See* Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

DATED MAR -7 2002 /s/ Jan Horbaly/kc
JAN HORBALY, CLERK

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

CIVIL MINUTES – GENERAL

Case No.: SA CV 98-822 AHS (EEx)

Date: February 7, 2001

Title: Simple Technology, Inc. v. Dense-Pac Microsystems, Inc.

PRESENT: **HON. ALICEMARIE H. STOTLER, JUDGE (IN CHAMBERS)**

Debra Beard	Not Present
Deputy Clerk	Court Reporter

ATTORNEYS PRESENT: None

PROCEEDINGS:

RULINGS: (1) DENYING DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY OF '916 PATENT; (2) DENYING DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF NON-INFRINGEMENT OF '916 PATENT; (3) DENYING PLAINTIFF'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF LITERAL INFRINGEMENT OF CLAIM 12 OF '916 PATENT[1]; (4) GRANTING PLAINTIFF/COUNTER-DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF NON-INFRINGEMENT OF DEFENDANT/COUNTER-CLAIMANT'S '694 PATENT; (5) DENYING DEFENDANT DENSE-PAC

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[1] **Docket Nos. 15, 17, and 26, respectively**, referring to Patent No. 5,154,907, which patent is reissued and now referred to in these proceedings as RE 36,916. See Minute Order of January 2, 2001.

MICROSYSTEM, INC.'S MOTION FOR LEAVE TO FILE SUPPLEMENTAL PAPERS IN OPPOSITION TO PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT OF NON-INFRINGEMENT OF '694 PATENT; (6) DENYING DEFENDANT'S MOTION TO EXCLUDE JOHN REED'S OPINION RE '694 PATENT; (7) DENYING PLAINTIFF'S MOTION TO DISMISS ANY AFFIRMATIVE DEFENSE OR TO AMEND THE COMPLAINT; (8) DENYING PLAINTIFF'S MOTION TO SUPPLEMENT COMPLAINT

Rulings on Enumerated Motions

1. *Defendant's Motion for Summary Judgment of Invalidity of Claim 12 of the '916 Patent*

The Court denies defendant's motion for summary judgment of invalidity of claim 12 of the '916 patent. Defendant fails to establish obviousness of claim 12 of the '916 patent in light of the Sasazawa and/or the Sasazawa/Kira prior art references.

2. *Defendant's Motion for Summary Judgment of Non-Infringement of Claim 12 of the '916 Patent*

The Court denies defendant's motion on non-infringement of claim 12 of the '916 patent. Defendant's M-Densus rail products do not literally infringe claim 12. A finding of literal infringement requires that every single element of a particular claim, or its equivalent, be present in the accused device. The M-Densus products do not employ "planar side boards." Thus, defendant's motion for judgment of non-infringement is denied, except to the extent that it is granted as to literal infringement.

3. *Plaintiff's Motion for Partial Summary Judgment of Literal Infringement of Claim 12 of the '916 Patent*

Plaintiff's motion is denied. See Paragraph 2.

4, 5 and 6. *Plaintiff/Counter-Defendant's Motion for Summary Judgment of Non-Infringement of Defendant/Counter-Claimant's '694 Patent*

A separate Order Granting Plaintiff/Counter-Defendant's Motion for Summary Judgment of Non-Infringement of Defendant/Counter-Claimant's '694 Patent; Denying Defendant's Motion for Leave to File Supplemental Papers Opposing Plaintiff's Motion for Summary Judgment of Non-Infringement of Defendant's '694 Patent; and Denying Defendant's Motion to Exclude John Reed's Opinion re the '694 Patent has been filed and ordered served on all counsel this date.

7 and 8. *Plaintiff's Motion to Dismiss any Affirmative Defense or to Amend the Complaint; and Plaintiff's Motion to Supplement Complaint*

A separate Order Denying Plaintiff's Motion to Dismiss Any Affirmative Defense or to Amend the Complaint; and Denying plaintiff's Motion to Supplement Complaint has been filed and ordered served on all counsel this date.

The Clerk shall serve this minute order on counsel for all parties in this action.

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

SIMPLE TECHNOLOGY Plaintiff, v. DENSE-PAC MICRO-SYSTEMS Defendants.	SA CV 98-822 AHS (EEx) MEMORANDUM ORDER GRANTING DEFENDANT'S MOTION FOR PARTIAL SUMMARY JUDGMENT AND ORDER FOR ENTRY OF JUDGMENT (Filed Mar. 29, 2001)

I.

PROCEDURAL BACKGROUND

On February 7, 2001, the Court ruled that plaintiff's Reissue Patent No. 36,916 ('916) was not infringed by defendant because the M-Densus rail products do not employ "planar side boards." The Court denied defendant's motion of non-infringement "except to the extent it is granted as to literal infringement." *See* Feb. 7, 2001 Minute Order. On February 23, 2001, defendant moved for partial summary judgment of non-infringement of claim 12 of the '916 patent in light of the Federal Circuit's decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000). Plaintiff filed opposition on March 9, 2001. Defendant filed a reply on March 16, 2001.

The parties' oral arguments were heard on March 23, 2001, and the motion was taken under submission.

The Court, having considered the papers submitted by the parties, the cases cited therein, and the oral arguments of counsel, grants defendant's motion. Because only Claim 12 is in issue in the complaint, and because all other issues have been adjudicated, the Court orders entry of judgment in favor of defendant.

II.

DISCUSSION

The Court holds that the phrase "planar side boards" should be characterized as a single limitation that has been the subject of amendment. *See Aclara v. Caliper Technologies Corp.*, 125 F.Supp. 2d 391, 402 (N.D. Cal. 2000) ("A limitation . . . is a series of limiting words or phrases that specifically identify the invention in the claims.") (internal quotations omitted); *see also Festo*, 234 F.3d at 563 ("It is preferable to use the term 'limitation' when referring to claim language and the term 'element' when referring to the accused device.").

During the course of this litigation, plaintiff has consistently referred to the phrase "planar side boards" as a single cohesive limitation. *See e.g.*, Malcolm Decl., Ex. O, Pla's Mot. for Partial Summary Judgment of Literal Infringement of Claim 12 of '907 patent at 6:19-24 ("To this point, Dense-Pac has only disputed the interpretation of two claim limitations: (1) "planar side boards" and (2). . . . "); 13:10-15 (" . . . Dense-Pac has argued that its products do not satisfy two limitations of Claim 12. However, Dense-Pac's arguments are based on an erroneous construction of Claim 12 and do not raise any factual issues regarding the structure of its product. A. *The Accused Products Contain Planar Side Boards.*").

Festo holds that any amendment "that narrows the scope of a claim for any reason related to the statutory requirements for a patent will give rise to prosecution history estoppel with respect to the amended claim element." *See Festo*, 234 F.3d at 564-65. Plaintiff amended its patent application to narrow "first side board" and "second side board" to "first planar side board" and "second planar side board" in response to prior art identified by the examiner. Malcolm Decl., Ex. E-7, 8. The Court finds the amendment to have "narrowed the literal scope of the claim" as contemplated by *Festo* in a prosecution history estoppel analysis. *Id.* at 585.

The court in *Aclara* characterized the consequence of creating prosecution history estoppel as "severe" under *Festo*, *Aclara*, 125 F. Supp. 2d at 391. Whether or not this is so, the Court finds that, in this case, imposition of a complete bar to application of the doctrine of equivalents follows the directive of *Festo*. More recent Federal Circuit decisions point to the same conclusion. *See e.g., Pioneer Magnetics v. Micro Linear Corp.*, 238 F.3d 1341 (Fed. Cir. 2001) (finding "plaintiff [to be] estopped from arguing equivalents to 'switching analog multiplier circuit' limitation of the claims in the '366 patent" where plaintiff had amended claim from "multiplier" to "switching analog multiplier" to avoid prior art which disclosed a power supply containing a non-switching multiplier); *Litton Systems v. Honeywell Inc.*, 238 F.3d 1376, 1380 (finding plaintiff to be "estopped from claiming any equivalents to the 'Kaufman-type ion beam gun' limitation in the disputed claims of the '849 reissue" where plaintiff had "narrowed its claims by amending the term 'ion beam source' to read 'Kaufman-type ion beam source' and the

accused devices did not literally possess a Kaufman-type ion beam gun).

III.

CONCLUSION

Accordingly, and for the foregoing reasons, the Court grants defendant's motion for partial summary judgment on the ground that, under *Festo* plaintiff is completely barred from seeking infringement on the basis of the doctrine of equivalents on account of plaintiff's amendment narrowing the limitation "planar side board." As noted, the Court has previously adjudicated literal infringement adverse to plaintiff.

The Court has this date modified, signed, and filed defendant's proposed Statement of Uncontroverted Facts and Conclusions of Law. The Clerk shall enter judgment for defendant.

IT IS ORDERED.

IT IS FURTHER ORDERED that the Clerk shall serve a copy of this Order on counsel for all parties in this action.

DATED: March 28, 2001.

/s/ Alicemarie H. Stotler
ALICEMARIE H. STOTLER
UNITED STATES DISTRICT JUDGE

Thomas R. Malcolm (State Bar No. 39248)
Richard J. Grabowski (State Bar No. 125666)
JONES, DAY, REAVIS & POGUE
5 Park Plaza, Suite 1100
Irvine, California 92614
Tel: (949) 851-3939
Fax: (949) 553-7539

Kenneth R. Adamo
JONES, DAY, REAVIS & POGUE
(admitted *Pro Hac Vice*)
901 Lakeside Avenue
Cleveland, Ohio 44114
Tel: (216) 586-3989
Fax: (216) 579-0212

Attorneys for Defendant and Counterclaimant
DENSE-PAC MICROSYSTEMS, INC.

UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

SIMPLE TECHNOLOGY, INC., a California corporation, Plaintiff, vs. DENSE-PAC MICROSYSTEMS, INC., a California corporation, Defendant.	Case No. SACV-98-822 AHS (EEx) **DEFENDANT AND COUNTERCLAIMANT DENSE-PAC MICROSYSTEMS, INC.'S STATEMENT OF UNCONTROVERTED FACTS AND CONCLUSIONS OF LAW IN SUPPORT OF ITS MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT OF CLAIM 12 OF UNITED STATES REISSUE**
DENSE-PAC MICROSYSTEMS, INC., a California corporation, Counterclaimant,	

vs.

SIMPLE TECHNOLOGY, INC., a California corporation,

Counterdefendant.

PATENT NO. 36,916 IN LIGHT OF FEDERAL CIRCUIT'S *FESTO* DECISION

TRIAL:

Trial Date: March 27, 2001
Time: 10:00 a.m.
Ctrm: 10A

HEARING:

Hearing Date: March 23, 2001
Time: 3:00 p.m.
Ctrm: 10A

Honorable
Alicemarie H. Stotler

[FILED UNDER SEAL]

(Filed Mar. 29, 2001)

CONFIDENTIAL – ATTORNEYS' EYES ONLY

FILED PURSUANT TO PROTECTIVE ORDER: CONTENTS NOT TO BE REVEALED EXCEPT (1) TO THE COURT AND THEN RESEALED, (2) BY AGREEMENT OF THE PARTIES, OR (3) BY PRIOR ORDER OF THIS COURT

Defendant and counterclaimant Dense-Pac Microsystems, Inc. ("Dense-Pac") submits that the facts set forth herein are uncontroverted for the purposes of its motion for partial summary judgment of non-infringement of claim 12 of United States Reissue No. 36,916 ("the '916 patent"). The '916 patent was substituted into this suit for the surrendered United States Patent No. 5,514,907 by the

Court's order of January 2, 2001. Malcolm Decl., Ex. A at p. 5 [*Minute Order* of Jan. 2, 2001 at p 2].

I. UNCONTROVERTED FACTS

A. Dense-Pac's Rail Design Does Not Literally Infringe Claim 12 of Simple's '916 Patent

1. On May 7, 1999, Plaintiff Simple Technology, Inc. ("Simple") limited the scope of the present litigation to claim 12 of its '916 patent when it unconditionally agreed not to assert any other claims of its patent against Dense-Pac based on any products currently or previously manufactured or sold by Dense-Pac. Malcolm Decl., Ex. B at pp. 7-10 [Plaintiff's Statement of Nonliability as to Claims 1-11 and 13-15 of United States Patent No. 5,514,907 re: Defendant's Motions for Summary Judgment of Invalidity and Noninfringement (filed May 7, 1999)]

2. Simple only alleges infringement as to four Dense-Pac products bearing Dense-Pac part nos. DPSC16MX8RY5, DPSD32MX4RY5, DPSD16MX8RKY5, and DPSD32MR72RW5-PC100. Complaint, ¶ 4. Each of these products uses a "rail" type design. Malcolm Decl., Ex. C at p. 12 [Simple's Statement of Uncontroverted Facts and Conclusions of Law in Support of its Motion for Partial Summary Judgment of Literal Infringement of Claim 12 of '907 Patent at ¶ 1].

3. On February 7, 2001, this Court denied Dense-Pac's motion for summary judgment, but simultaneously held Dense-Pac's rail products do not literally infringe claim 12 of the '916 patent. Malcolm Decl., Ex. D at p. 20 [*Minute Order* (Feb. 7, 2001)] at p. 2.].

4. In granting in part Dense-Pac's motion for summary adjudication of noninfringement, this Court held:

> Defendant's M-Densus rail products do not literally infringe claim 12. A finding of literal infringement requires that every single element of a particular claim, or its equivalent, be present in the accused device. The M-Densus products do not employ "planar side boards." Thus, defendant's motion for summary judgment of noninfringement is denied, except to the extend [sic] that it is granted as to literal infringement.

Malcolm Decl., Ex. D at p. 20 [*Minute Order* (Feb. 7, 2001)] at p. 2.].

B. The Prosecution History of the '916 Patent and Amendment Adding "Planar" to Narrow Scope of Claim 12.

5. When the application that became the '907 patent was initially filed, the Patent Office had already issued patents for stacked semiconductor chips. These prior art patents limit the scope of the claims of the '907 patent. Malcolm Decl., Ex. E [Certified Copy of Prosecution History of U.S. Patent No. 5,514,907]. For example, U.S. Patent No. 5,016,138 issued to Woodman ("Woodman patent"), U.S. Patent No. 5,343,075 issued to Nishino ("Nishino patent"), Japanese Patent No. JP 4-209562 ("Uzuka patent") and Japanese Open Patent Application No. Hei 6-77644 ("Sasazawa reference"), all describe side boards used to construct a stacked semiconductor chip module. Malcolm Decl., Exs. F, G, H, & I.

6. In light of the prior art references, the Patent Office rejected claims 7-15 as being obvious and unpatentable under 35 U.S.C. § 103. Malcolm Decl., Ex. E, p. 97 ['907 File History, Tab 6, p. 4 (Sept. 18, 1995 Office Action)]. In its office action, the examiner explained:

> Claims 7-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Uzuka et al. (JP 4-209562) applicant's submitted prior art.
>
> Uzuka et al. teach a device including first and second side boards 12, 12' with plurality of standard surface mount identical chip(s) 1 stacked between the side boards where each chip of the plurality conductively connected to the (sic) both first and second side boards (pins 15-2 are conductively connected through holes/vias 12-1), and a low pin 3 adjacent to a low (sic) most chip, wherein the lowermost pins serve as leg supports for the whole circuit.

Malcolm Decl., Ex. E, p. 97 ['907 File History, Tab 6, p. 4 (Sept. 18, 1995 Office Action)].

7. On November 3, 1995, the examiner, Jhihan Clark, his supervisor, Dr. Sara Crane, and Simple's patent attorney, William H. Shreve, had an interview regarding patentability of claim 7. Malcolm Decl., Ex. E, p. 100 ['907 File History, Tab 7, p. 2 (Nov. 11, 1995 Examiner Interview Summary Record)].[1] Indeed, the Examiner Interview

---

[1] Claim 12 was initially a dependent claim dependent on independent claim 7. Malcolm Decl., Ex. J [U.S. Patent No. 5,514,907]. During the reissue process, claim 7 was canceled, and Claim 12 was rewritten as an independent claim incorporating all of claim 7's language and elements. Malcolm Decl., Ex. K [U.S. Patent No. Re. 36,916].

Summary Record indicates that the only issue discussed was claim 7. Malcolm Decl., Ex. E, p. 100 ('907 File History, Tab 7, p. 1 (Nov. 11, 1995 Examiner Interview Summary Record)). The examiner described the nature of the conversation as follows:

> We discussed definitions of claim terms "planar" and "pads." We also discussed language to further define pin geometry on the chips. Applicant will submit an amendment. Claim language as attached would define over the 3 references above.

Malcolm Decl., Ex. E, p. 100 ('907 File History, Tab 7, p. 2 (Nov. 11, 1995 Examiner Interview Summary Record)).

8. The three prior art references were JP 4-209562 (the "Uzuka, et al patent"), JP 61-63048 (the "Kageyama patent") and U.S. Patent No. 5,343,075 (the "Nishino patent"). Malcolm Decl., Ex. E, p. 100 ('907 File History, Tab 7, p. 2 (Nov. 11, 1995 Examiner Interview Summary Record)).

9. Simple provided a proposed claim amendment adding "planar" to modify side boards, which is attached to the Examiner Interview Summary Record, and reads as follows (underlined words represent words being added; *italicized* words represent handwritten notes indicating language that examiner recommended also be added):

> 7. (Twice Amended) A module that includes at least one multi-chip module, said module comprising:
>
> a circuit board having at least first and second sets of surface mount pads;

> a first planar side board including a plurality of surface mount pads positioned along its bottom edge, said plurality of surface mount pads of said, first side board being surface-mounted to said first set of surface mount pads such that said first side board is substantially perpendicular to said circuit board;
>
> a second planar side board including a plurality of surface mount pads positioned along its bottom edge, said plurality of surface mount pads of said second side board being surface-mounted to said second set of surface mount pads such that said second side board is substantially perpendicular to said circuit board and substantially parallel to said first side board; and
>
> a plurality of standard surface mount chips *having a plurality of pins, a portion of each pin extending below a bottom surface of the corresponding chip* stacked between said side boards, each chip of said plurality conductively connected to said first side board and said second side board.

Malcolm Decl., Ex. E, p. 101 ['907 File History, Tab 7, p. 3 (Nov. 11, 1995 Examiner Interview Summary Record)]. The examiner's handwritten notes in the margin of the suggested amendment states that Simple "will define in remarks" the circled terms "planar" and "pads."

10. On December 21, 1995, Simple filed an amendment to claim 7 inserting "planar" to modify side boards as well as some of amendments not relevant here. The amendment submitted by Simple reads as follows (underlined words represent added language):

7. (Twice Amended) A module that includes at least one multi-chip module, said module comprising:

a circuit board having at least first and second sets of surface mount pads;

a first planar side board including a plurality of surface mount contacts positioned along an edge of said side first board which abuts said circuit board, said plurality of surface mount contacts of said, first side board being surface-mounted to said first set of surface mount pads of said circuit board such that said first side board is substantially perpendicular to said circuit board;

a second planar side board including a plurality of surface mount contacts positioned along an edge of said second side board which abuts said circuit board, said plurality of surface mount contacts of said second side board being surface-mounted to said second set of surface mount pads of said circuit board such that said second side board is substantially perpendicular to said circuit board and substantially parallel to said first side board; and

a plurality of standard surface mount chips stacked between said side boards, each chip including a plurality of each pin extending beyond a chip surface which lies generally parallel to said circuit board with said chip positioned between said side boards, each chip of said plurality conductively connected to said first side board and said second side board.

Malcolm Decl., Ex. E, p. 102-103 ['907 File History, Tab 8, pp. 1-2 (Applicant's Response to Office Action dated Dec. 6, 1995)].

11. In the Remarks section of the response, applicant explained that these amendments were responsive to the prior art rejection. *Id.* at pp. 104-105 (section entitled "Response to Prior Art Rejection" at p. 3-4). Thus, in light of and responsive to the obviousness rejection, Simple stated:

> Applicant also has more particularly pointed out and distinctly claimed the recited module by claiming the planar nature of the side boards. By "planar," Applicant means a flat plate which has generally uniform rectangular cross-section. . . .
>
> . . .
>
> The examiner also indicated that the proposed amendments to claim 7 would further distinguish the Uzuka, Kageyama, and Nishino patents. Applicant therefore respectfully requests the Examiner to reconsider the rejection of claim 7 in view of the amendments which define further several noval elements of the multi-chip module, and to withdraw the rejection.

Malcolm Decl., Ex. E, p. 107-108 ['907 File History, Tab 8, pp. 6 & 7 (Applicant's Response to Office Action dated Dec. 6, 1995)].

12. Simple explained that the use of planar side boards was a patentable, nonobvious improvement over the prior art because such a design

> "reduces the costs of the module. . . . The planar side boards also are cut from conventional cladding. No special fabrication process (e.g., milling,

> molding or assembling) is required to alter the generally uniform thickness of the planar side board. Fabrication costs are thus reduced over prior designs, such as that illustrated in the Nishino patent."

Malcolm Decl., Ex. E, p. 105-106 ('907 File History, Tab 8, p. 4-5 (Applicant's Response to Office Action dated Dec. 6, 1995)).

13. Indeed, Simple continues to assert that the addition of the term "planar" was to overcome the Nichino patent. In its opposition to Dense-Pac's initial motion for summary adjudication of non-infringement, Simple stated:

> The amendment made to Claim 12 was the addition of the term "planar." [citation omitted] This amendment was made to distinguish the Nishino patent which disclosed a pair of support plates that were fashioned in an "L"-shaped design.

Malcolm Decl., Ex. L at p. 236 [Simple's Opposition to Dense-Pac's Motion for Summary Adjudication of Non-infringement of Claims 1-15 of United States patent No. 5,514,907 p. 24 (filed April 26, 1999)].

14. On January 5, 1996, the Patent Office issued a Notice of Allowability indicating that the amendments, in the examiner's view, overcame the prior art references. Malcolm Decl., Ex. E, p. 112 ['907 File History, Tab 9, p.1 (Notice of Allowability)].

15. On May 7, 1996, the PTO issued U.S. Patent No. 5,514,907. Malcolm Decl., Ex. J [U.S. Patent No. 5,514,907].

16. Claim 12 of the '907 patent – the only claim still at issue in the present suit – reads as follows:

> A module as defined in claim 7, wherein a lowermost chip of said plurality is soldered to said first and second sets of surface mounts.

Malcolm Decl., Ex. J at p. 192 [U.S. Patent No. 5,514,907 at col. 8, lns. 39-41.].

17. On April 22, 1998, Simple filed for a reissue of the '907 patent in which it added 28 new claims and canceled claim 7. Claim 12 was re-written to include all of the language originally contained in claim 7. Claim 12 in the '916 patent reads as follows (language in brackets [ ] being omitted and language in italics being added):

> 12. A module [as defined in claim 7] *that includes at least one multi-chip module, said module comprising:*
>
> *a circuit board having at least first and second sets of surface mount pads;*
>
> *a first planar side board including a plurality of surface mount contacts positioned along an edge of said side first board which abuts said circuit board, said plurality of surface mount contacts of said, first side board being surface-mounted to said first set of surface mount pads of said circuit board such that said first side board is substantially perpendicular to said circuit board;*
>
> *a second planar side board including a plurality of surface mount contacts positioned along an edge of said second side board which abuts said circuit board, said plurality of surface mount contacts of said second side board being surface-mounted to said second set of surface mount pads of said circuit board such that said second side board is substantially perpendicular*

to said circuit board and substantially parallel to said first side board; and

a plurality of standard surface mount chips stacked between said side boards, each chip including a plurality of each pin extending beyond a chip surface which lies generally parallel to said circuit board with said chip positioned between said side boards, each chip of said plurality conductively connected to said first side board and said second side board.

wherein a lower-most chip of said plurality is soldered to said first and second sets of surface mounts.

Malcolm Decl., Ex. K at p. 206 [United States Patent Re. 36,916 (issued October 17, 2000) at col. 8, lns. 2858 (emphasis added)].

II. CONCLUSIONS OF LAW

A. Summary Judgment in Patent Cases

1. Summary judgment is proper when "there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c); *see Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 106 S.Ct. 2548, 2552, 91 L.Ed.2d 265 (1986).

2. "Summary judgment is as appropriate in a patent case as it is in any other case." *Desper Products, Inc. v. OSound Labs, Inc.*, 157 F.3d 1325, 1332 (Fed. Cir. 1998); *see C.R. Bard, Inc. v. Advanced Cardiovascular, Inc.*, 911 F.2d 670, 672 (Fed. Cir. 1990).

B. Doctrine of Equivalents

3. Patent infringement may be found either literally or under the doctrine of equivalents. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997).

4. The doctrine of equivalents prevents an accused infringer from avoiding liability for infringement by changing only minor or insubstantial details of a claimed invention while retaining the invention's essential identity. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608, 70 S.Ct. 854, 94 L.Ed. 1097 (1950); *Warner-Jenkinson Co.*, 520 U.S. at 25-27, 117 S.Ct. at 1045, 137 L.Ed.2d 146.

5. Analysis under the doctrine of equivalents requires an element-by-element correspondence between the accused product and the claimed invention. *Warner-Jenkinson*, 520 U.S. at 29, 40.

6. The doctrine of equivalents is utilized "'[t]o temper unsparing logic and prevent an infringer from stealing the benefit of the invention.'" *Graver Tank*, (quoting *Royal Typewriter Co. v. Remington Rand, Inc.*, 168 F.2d 691, 692, 77 U.S.P.Q. 517, 518 (2d Cir.1948) (Hand, J.)).

7. In pursuing these goals, the doctrine attempts to strike a balance between ensuring that the patentee enjoys the full benefit of his patent and ensuring that the claims give "fair notice" of the patent's scope. *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538, 20 U.S.P.Q.2d 1456, 1458-59 (Fed. Cir.1991).

8. This balance can be easily upset, however, because "the doctrine of equivalents, when applied broadly,

conflicts with the definitional and public-notice functions of the statutory claiming requirement." *Warner-Jenkinson*, 520 U.S. at 29, 117 S.Ct. 1040.

C. Prosecution History Estoppel

9. Prosecution history estoppel is one tool that prevents the doctrine of equivalents from vitiating the notice function of claims. *Charles Greiner & Co. v. Mari-Med Mfg., Inc.*, 962 F.2d 1031, 1036, 22 U.S.P.Q.2d 1526, 1529-30 (Fed.Cir.1992).

10. Actions by the patentee, including claim amendments and arguments made before the Patent Office, may give rise to prosecution history estoppel. *Pharmacia & Upjohn Co. v. Mylan Pharms., Inc.*, 170 F.3d 1373, 1376-77, 50 U.S.P.Q.2d 1033, 1036 (Fed.Cir.1999).

11. "Prosecution history estoppel precludes a patentee from obtaining under the doctrine of equivalents coverage of subject matter that has been relinquished during the prosecution of its patent application." *Id.* at 1376, 50 U.S.P.Q.2d at 1036.

12. The logic of prosecution history estoppel is that the patentee, during prosecution, has created a record that fairly notifies the public that the patentee has surrendered the right to claim particular matter as within the reach of the patent. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 564-565, 56 U.S.P.Q.2d 1865 (Fed. Cir. 2000) (*en banc*).

13. The application and scope of prosecution history estoppel is a legal question for the court to determine. *Desper Products*, 157 F.3d at 1338 (citing *Labounty Mfg.*,

Inc. v. United States Int'l Trade Comm'n, 867 F.2d 1572, 1576 (Fed. Cir. 1989)).

D. The Federal Circuit's *en banc* Decision in *Festo Corp. v. Shoketsu Kinsoku Kogyo Kabushiki Co., Ltd.*

1. No Range of Equivalents Given to Amended Claim Element

14. "When a claim amendment creates prosecution history estoppel with regard to a claim element, there is no range of equivalents available for the amended claim element. Application of the doctrine of equivalents to the claim element is completely barred (a "complete bar")." *Festo Corp.*, 234 F.3d at 569.

2. The *Festo* Procedure

15. Finding that prosecution history estoppel creates a "complete bar" to the doctrine of equivalents, the Federal Circuit set forth a straightforward procedure for determining whether prosecution history estoppel applies.

> The first step in a prosecution history estoppel analysis is to determine which claim elements are alleged to be met by equivalents. Then, the court must determine whether the elements at issue were amended during prosecution of the patent. . . . If the claim elements at issue were amended, the court first must determine whether the amendment narrowed the literal scope of the claim. If so, prosecution history estoppel will apply unless the patent holder establishes that the amendment was made for a purpose unrelated to patentability. If the patent holder fails to do so, prosecution history estoppel

> will bar the application of the doctrine of equivalents to that claim element.

Id. at 586.

3. Narrowing Amendments Trigger Prosecution History Estoppel

16. "For the purposes of determining whether an amendment give rise to prosecution history estoppel, a 'substantial reason related to patentability' is not limited to overcoming or avoiding prior art, but instead includes any reason which relates to the statutory requirements for a patent." *Id.* at 566.

17. "Therefore, a narrowing amendment made for any reason related to the statutory requirements for a patent will give rise to prosecution history estoppel with respect to the amended claim element." *Id.*

[E. 20. lined out by judge /s/ AHS]

F. Retroactive Application of *Festo*

21. The holding in *Festo* applies retroactively to all extant claims amended for patentability purposes. *See Pioneer Magnetics, Inc. v. Micro Linear Corp.*, ___ F.3d ___, 2001 U.S. App. LEXIS 846 (Fed. Cir. Jan. 23, 2001); *Litton Systems, Inc. v. Honeywell Corp.*, ___ F.3d ___, 2001 U.S. App. LEXIS 1529 (Fed. Cir. Feb. 5, 2001); and *Biovail Corp. Int'l v. Andrx Pharms., Inc.*, ___ F.3d ___, 2001 U.S. App. LEXIS 2092 (Fed. Cir. Feb. 13, 2001).

G. Conclusions Of Law In This Case

22. The element at issue for the purposes of this motion is the "planar side boards" of claim 12. The Court has ruled as a matter of law that Dense-Pac's rail products do not literally infringe Simple's '916 patent because they do not employ "planar side boards." Malcolm Decl., Ex. D at p. 20 [Minute Order of February 7, 2001 at p. 2].

23. On December 6, 1995, Simple amended claim 7 (upon which claim 12 was dependent) inserting the adjective "planar" to specify and limit its "side boards." Malcolm Decl., Ex. E, p. 103 ['907 File History, tab 8, p.2 (Applicant's Response to Office Action dated Dec. 6, 1995)].

24. Simple modified claim 7 to narrow the meaning of "side boards" in order to overcome a prior art rejection. Malcolm Decl., Ex. E, p. 103, 107 & 108 ['907 File History, Tab 8, p. 2, 6 & 7 (Applicant's Response to Office Action dated Dec. 6, 1995)].

25. Specifically, Simple narrowed its claim to include only side boards of a planar nature in order to avoid the Uzuka and Nishino prior art references. Simple has admitted as much stating:

> The amendment made to Claim 12 was the addition of the term "planar." [citation omitted] This amendment was made to distinguish the Nishino patent which disclosed a pair of support plates that were fashioned in an "L"-shaped design.

Malcolm Decl., Ex. L at p. 236 [Simple's Opposition to Dense-Pac's Motion for Summary Adjudication of Non-infringement of Claims 1-15 of United States Patent No. 5,514,907 at p. 24 (filed April 26, 1999)].

26. The amendment was made for a "substantial reason related to patentability" – namely to overcome an obviousness rejection under 35 U.S.C. § 103. *Festo Corp.*, 234 F.3d at 566 & 568.

27. Prosecution history estoppel applied and, therefore, completely bars the application of the doctrine of equivalents as to the claim element "planar side boards." *Id.* at 569.

28. Because Dense-Pac's rail products do not literally infringe claim 12's "planar side board" element as a matter of law, Malcolm, Decl., Ex. D at p. 20, and because this element is not permitted any equivalency under the doctrine of equivalents, *Festo Corp.*, 234 F.3d at 569, Dense-Pac cannot as a matter of law be found to have infringed the '916 patent.

29. All of Simple's allegations of literal infringement and infringement by equivalents have been ~~extinguished~~, [adjudicated on the one hand and barred as a matter of law on the other, /s/ AHS] partial summary judgment should be entered against Plaintiff Simple and for the Defendant Dense-Pac on claims of infringement of [claim 12 of /s/ AHS] the '916 patent.

Dated: February 23, 2001

Respectfully submitted,

JONES, DAY, REAVIS & POGUE

By: /s/ Thomas R. Malcolm
Thomas R. Malcolm
Attorneys for Defendant
DENSE-PAC MICRO-SYSTEMS, INC.

IT IS SO ORDERED
DATED March 28, 2001.
/s/ Alicemarie H. Stotler
U.S. District Judge

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

SIMPLE TECHNOLOGY, INC., Plaintiff, v. DENSE-PAC MICROSYSTEMS, INC., Defendant.	) SA CV 98-822 AHS (EEx))))) JUDGMENT)))) (Filed Mar. 29 2001)))

The Court, having denied Defendant's Motion for Summary Judgment of Non-Infringement of United States Patent No. Re. 36,916 ("'916 patent"), having granted, in part, that motion as to literal infringement, having denied Defendant's Motion for Summary Judgment as to Invalidity of Plaintiff's '916 patent, having denied Plaintiff's Motion for Summary Judgment as to Infringement of Claim 12 of the '916 patent, having granted Plaintiff's Motion for Summary Judgment as to Non-infringement of Defendant's '694 patent, and having granted Defendant's Motion for Partial Summary Judgment of Non-Infringement of Claim 12 of the '916 patent, these matters having come before the Court, the Honorable Alicemarie H. Stotler, District Judge, presiding, and the evidence presented having been fully considered, the issues having been duly considered, and decisions thereon having been duly rendered,

IT IS ORDERED AND ADJUDGED:

that plaintiff take nothing on its complaint, that defendant take nothing on its counter-claim, and that defendant shall, as the prevailing party, recover its costs of suit.

DATED: March 28, 2001.

/s/ Alicemarie H. Stotler
ALICEMARIE H. STOTLER
UNITED STATES DISTRICT JUDGE